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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,390	06/23/2003	Bradley Emalfarb	00254-0072	8046
32116 7590 05/25/2010 WOOD, PHILLIPS, KATZ, CLARK & MORTIMER 500 W. MADISON STREET SUITE 3800 CHICAGO, IL 60661				
EXAMINER				
BROWN, ALVIN L				
ART UNIT		PAPER NUMBER		
3622				
MAIL DATE		DELIVERY MODE		
05/25/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/601,390

**Applicant(s)**

EMALFARB, BRADLEY

**Examiner**

ALVIN BROWN

**Art Unit**

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12 January 2010 has been entered. Claims 1-22 are pending.

### ***Response to Amendment***

1. The Declaration filed on 12 January 2010 under 37 CFR 1.131 has been considered but is ineffective to overcome the **Keach (20060213102)** reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Keach reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). Applicant claims in the Declaration "I invented the subject matter claimed in the above application prior to June 16, 2003" is not sufficient to overcome the prior art rejection. Examiner notes that Applicant has not submitted any evidence of conception. Further, the affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to

the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred."). (MPEP 715.07 [R-3])

Examiner further notes that even if evidence of conception is established, Applicant must also submit evidence to establish diligence from at least the date Applicant is claiming conception to at least 29 May 2003, the date Inventor's attorney was retained.

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) tied to a particular machine or apparatus (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or

materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-13, 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalt et al., (6,897,786) in view of Keach (20060213102) further in view of Turnpike: Doing What It Does Best?, Matthew Purdy, New York Times, New York, NY, November 7, 1999, pg. B 37, ("Turnpike").**

**As per claims 1, 13,** Kalt discloses a method of generating revenue from the right to display advertising information on or adjacent to a public right-of-way, the method comprising the steps of:

providing a support on or adjacent to a public right-of-way, the public right-of-way including at least one lane for vehicle traffic to move in a first direction and a second

lane spaced to a side of the one lane for vehicle traffic to move in a second direction oppositely to the first direction (column 1, lines 25-40);

providing a first type of information on the support, the first type of information placed in a manner that the first type of information is viewable by an occupant of a vehicle in the one lane moving in a first direction and facing generally in the first direction (column 1, lines 25-40).

Kalt does not explicitly disclose the information is maintained and/or regulated by a federal or local authority; and

the first type of information placed by the federal or local authority that maintains and/or regulates the public right-of-way and of a nature that is conventionally placed by federal or local authorities that maintain and/or regulate public right-of-ways to aid the navigation of vehicles on the public right-of-way.

However, Keach discloses information maintained and/or regulated by a federal or local authority; and

the first type of information placed by the federal or local authority that maintains and/or regulates the public right-of-way and of a nature that is conventionally placed by federal or local authorities that maintain and/or regulate public right-of-ways to aid the navigation of vehicles on the public right-of-way (paragraphs [0009-0011]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Keach's highway overhead information maintained by the government to Kalt's highway overpass traffic signs. One would be motivated to do this in order to provide motorists with traffic information.

Kalt does not explicitly disclose providing advertising information that is different type than the first type of information, on the support for and entity that is not the federal or local authority that maintains and /or regulates the public right-of-way so that the advertising information is viewable by an occupant of a vehicle moving in the second direction in one of the lanes and facing in the second direction ; and charging a fee to an entity to allow the advertising information to be maintained on the support by the entity.

However, Turnpike discloses providing advertising information that is different type than the first type of information, on the support for and entity that is not the federal or local authority that maintains and /or regulates the public right-of-way so that the advertising information is viewable by an occupant of a vehicle moving in the second direction in one of the lanes and facing in the second direction; and charging a fee to an entity to allow the advertising information to be maintained on the support by the entity (page B 37, where two sided billboards offer advertisement for turnpike traffic at a cost to advertisers).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Turnpike's two sided billboards to the combination of Kalt and Keach highway overpass traffic signs. One would be motivated to do this in order to provide advertisers with new ways of advertising their products.

**As per claim 2**, Turnpike further discloses the step of providing advertising information comprises providing the advertising information on a substantially flat, first display surface facing in the first direction (page B37).

**As per claim 3**, Kalt further discloses the step of providing information comprises providing a first type of information on a substantially flat, second display surface facing oppositely to the first direction (column 1, lines 25-40).

**As per claim 4**, Turnpike further discloses the step of illuminating the advertising information (page B37).

**As per claims 5-8, 16-19**, Kalt further discloses providing a first type of information on a first display surface that is on the support in an elevated position and at least partially directly over the one lane (column 1, line 64 - column 2, line 16, the sign is disclosed to be mounted on overpasses of highways which is equivalent to at least one traffic lane).

**As per claims 9-12, 20-22**, Turnpike further discloses providing a first type of information on a first display surface with a first area on the support, and the step of providing advertising information comprises providing advertising information on a second display surface with a second area on the support so that the first and second areas overlap both sideways and in a vertical direction (page B37).

**As per claim 15**, Kalt discloses there is a first shoulder region to a side of the first and second lanes opposite to the one side and the step of providing the second display system comprises providing the second display system at least partially directly over the first shoulder region (column 1, line 64 - column 2, line 16, where near the roadway is equivalent to shoulder region).

3. **Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kalt et al., (6,897,786) in view of Keach (20060213102) further in view of Turnpike:**



**Doing What It Does Best?**, Matthew Purdy, New York Times, New York, NY, November 7, 1999, pg. B 37, ("Turnpike") further in view of Mudryk et al., (6,267,529).

As per claim 14, the Kalt, Keach and Turnpike combination discloses the claimed invention as in claim 13. The combination does not disclose there is a center median between the first and second lanes and the third and fourth lanes, and the step of providing the second display system comprises providing the second display system at least partially over the center median.

However, Mudryk discloses there is a center median between the first and second lanes and the third and fourth lanes, and the step of providing the second display system comprises providing the second display system at least partially over the center median (column 1, lines 15-33).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Mudryk's highway median sign to Kalt's highway traffic signs. One would be motivated to do this in order to provide advertisers with new ways of advertising their products.

#### ***Response to Arguments***

Applicant's arguments filed 12 January 2010 have been fully considered but they are not persuasive. In regards to the 35 U.S.C. 101 rejection Applicant submits that "Applicant's claimed subject matter is tied into the apparatus specifically required in all claims" is sufficient to meet the requirements of Section 35 U.S.C. 101. Examiner respectfully disagrees since *In re Bilski* states that the applicants' process as claimed

does not transform any article to a different state or thing. Purported transformations or manipulations simply of providing a first type of information on the support or the right to display advertising information on or adjacent to a public right-of-way abstractions cannot meet the test because they are not physical objects or substances, and they are not representative of physical objects or substances. Applicant's process at most incorporates only such ineligible transformations. Therefore, a mere transmission of enhancements is insufficient to overcome the 35 U.S.C. 101 rejection. In regards to the Declaration filed on 12 January 2010 under 37 CFR 1.131 Examiner notes that the evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Keach reference.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALVIN BROWN whose telephone number is (571)270-5109. The examiner can normally be reached on Monday - Thursday 7:30 AM to 5:00 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571.272.6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ALB

/Arthur Duran/  
Primary Examiner, Art Unit 3622